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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/609,446

06/27/2003

Robert J. Schuller

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EXAMINER

CARLSON, JEFFREY D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/609,446	Applicant(s) SCHULLER ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____. |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/27/03, 10/02/03, 1/21/04, 3/2/04, 4/6/04, 4/4/05.

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

- Claim 8 states where part of the system (the scale) is located, yet the location of the scale does not further define any structural features of the system itself. Applicant could theoretically define and claim the required structure of a “perishable department” in combination with the incentive system. However, it is not clear if applicant has proper support for what would be distinctly be required of a “perishable department.” Alternatively, applicant could present this feature as part of a method claim by claiming the step of locating such a system within a perishable department of a store.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hewitt et al ('797') (US Pat 5578797).

4. Regarding claims 1, 6, Hewitt et al ('797') teaches a scale in a perishable store department that accepts identification of a product (i.e. PLU), weighs and prices identified products (such as perishable bagels). The scale prints label portions that include information about the identified product, a price for the weighed product and a barcode for easily identifying the product and its price at the POS as is generally known [fig 6A]. Hewitt et al ('797') also teaches a label portion that includes an incentive coupon for a discount on a product different from, but related to the weighed product; the coupon has a barcode for easy identification and redemption at the POS [col 4: lines 47-52, 5:1-4, 20-23]. The customer buying the bagels and choosing to also purchase the incentive cream cheese presents both products and the coupon which results in an automatic discount as is generally accepted with POS systems.

5. Regarding claims 2-4, the label of fig 6A can be reasonably taken to be a single product label including a product portion and a coupon portion. Fig 6A can also be reasonably taken to provide two labels (a product label and a coupon label separated by a perforation boundary). Certainly when the customer separates the label at the perforation as directed by Hewitt et al ('797'), what results is two labels with respective printing on them. Hewitt et al ('797') also teaches displaying coupon information on a display [6:4-10]. This is taken to represent printing incentive information to non-label media.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797').

8. Regarding claims 5, 23, 27, it would have been obvious to one of ordinary skill at the time of the invention to have offered multiple coupons (such as buy weighed hamburger patties - get a coupon for ketchup and a coupon for mustard), as a mere duplication of parts. MPEP 2144.04. Where giving a coupon is seen as advantageous, one of ordinary skill would find it predictably advantageous to offer multiple coupons for related items, thus encouraging even more purchases.

9. Regarding claims 24-26, the label of fig 6A can be reasonably taken to be a single product label including a product portion and a coupon portion. Fig 6A can also be reasonably taken to provide two labels (a product label and a coupon label separated by a perforation boundary). Certainly when the customer separates the label at the perforation as directed by Hewitt et al ('797'), what results is two labels with respective printing on them. Hewitt et al ('797') also teaches displaying coupon information on a display [6:4-10]. This is taken to represent printing incentive information to non-label media.

10. Claims 4, 8, 15, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') in view of AC-3000 (Ishida AC-3000 Series brochure, 6 pages – cited by applicant 6/27/2003).

11. Regarding claim 4, 8, 26, does not appear to teach printing coupons on a separate receipt (non-label) paper media. AC-3000 teaches the ability for such a scale to print to adhesive labels as well as to receipts. Hewitt et al ('797') also teaches that the targeted coupon need not be printed on the weighed product's label as in fig 6A - it can be merely displayed [6:4-10]. Official notice is also taken that it is well known to print coupons and other incentive information on a receipt. It would have been obvious to one of ordinary skill at the time of the invention to have printed the desired related coupon information on the customer's receipt. Doing so would not require the customer to go to the trouble of tearing the coupon from the product label.

12. Regarding claim 15, Hewitt et al ('797') prints a message encouraging the customer to also purchase the targeted related product. Hewitt et al ('797') identifies the product name and description so that the customer can understand what is being offered. It would have been obvious to one of ordinary skill at the time of the invention to have further explained to the customer where the product is located so as to help the customer find the product being encouraged for purchase. Further, the " BEST FOODS CAJUN SPICES" language acts as information indicating where in the store the item is located – i.e. in the Spices section. Further still, the differences between the incentive information printed by Hewitt et al ('797') and the information in the claims is only found in the nonfunctional descriptive material and is not functionally related to the structure of

the apparatus. The printer and associated structure is provided the same regardless of the content to be printed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have printed any type of data content.

13. Claims 7, 9-14, 16-22, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') as above and further in view Sheehan (US2002/0178060).

Regarding claims 7, 9-14, 16-20, 28, while Hewitt et al ('797') indeed teaches incentive information printed in a narrative, human-friendly form (".50 on one 9oz packet of BEST FOODS CAJUN SPICES") which is taken to be "code-free", the definition in the specification is taken to define the "code-free" claim limitation as one where there is no coupon code or coupon barcode to enter at the POS – the originating product code is sufficient to index the related incentive(s). In that manner, Hewitt et al ('797') does not teach coupons redeemed without some sort of coupon-specific entry at the POS. Sheehan however teaches the concept of electronic coupons which are associated with an identifier. In this manner, only the parent identifier need be scanned/entered at the POS and the associated coupons can be identified. Sheehan describes the benefit:

[0021] Electronic coupons also save time at the time of checkout and reduce the possibility of error. Instead of having to enter each coupon manually or scan each paper coupon, one swipe of a smart card or one check of a centralized

database (performed, perhaps, during a credit check) would allow all appropriate electronic coupons to be processed.

It would have been obvious to one of ordinary skill at the time of the invention to have used any scannable code (such as the originating identifier for the weighed product, or a single incentive barcode) as a means to identify any number of related child coupons (cream cheese, etc) associated with the originating qualifying product (bagels). In this manner, customers do not have to be bothered by tearing the perforated coupon, collecting, holding and managing the coupons. Further, redemption is made easier when the child coupons are identified simply by scanning the originating product identifier rather than scanning each individually collected paper/label coupon.

14. Regarding claim 21, it would have been obvious to one of ordinary skill at the time of the invention to have required the customer to present the originating weighed product/productID when redeeming the earned coupon(s). Otherwise, customer might pretend they wanted to buy the weighed shrimp just to get a coupon for the spices. One of ordinary skill would recognize the need to verify the qualifying purchase before the related incentive was granted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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jdc